

## **REMARKS**

Claims 1, 3, 4, 6, 8-10, 12, 14-28, and 34-42 were pending in the application, of which claims 14-16, 18-28, and 35 were previously withdrawn from consideration. By this paper, claims 43-45 are added. Upon entry of this Amendment, claims 1, 3, 4, 6, 8-10, 12, 14-28, and 34-45 will be pending in the application. Of those, claims 1, 3, 4, 6, 8-10, 12, 17, 34, and 36-45 are presented for further examination. Prompt and favorable examination of these claims is respectfully requested.

Applicants request rejoinder of withdrawn claims 14-16, 18-28, and 35 if generic claim 1 from which they depend is found allowable.

### **I. Interview Summary**

The undersigned wishes to acknowledge and thank the Examiner for the courtesies extended to him in a telephone interview conducted between the parties on March 4, 2008. In the interview, the parties generally discussed independent claims 1 and 36 and application of *Killion* (U.S. Patent No. 6,876,749) thereto. More particularly, the parties discussed the various structural differences between the microphone assembly of *Killion* and the microphone assembly claimed by Applicants. No agreements were made regarding the claims.

### **II. Claim Rejections: 35 U.S.C. § 103**

Claims 1, 3, 4, 6, 8-10, 12, 17, 34, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Killion*. However, the Office has failed to establish a *prima facie* case of obviousness with regard to these claims. Applicants request reconsideration and withdrawal of these rejections.

At the outset, Applicants point out that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 385 (2007), noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. See, M.P.E.P. 2142. The Federal Circuit has also stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see, M.P.E.P. 2142.

In the present case, independent claim 1 is generally directed toward a microphone assembly. Claim 1 recites (in part) that the assembly generally includes one or more sound inlet ports and a controlling device that forms part of the one or more sound inlets ports. Claim 1 also recites (in part) that the controlling device is a switch selected from the group consisting of a push button, a tragus responsive switch, and a turning knob.

The Office fails to provide a clear, explicit reason as to why the above emphasized features, in combination with the other features of claim 1, are obvious. The Office states with regard to these emphasized features that “it would have been obvious to one skilled in the art to provide any type of switch such as a push button or a turning knob for the actuator switch (75) of *Killion* for better adjusting and operating the device.” Office Action, page 3. But this statement is merely conclusory in nature and provides no clear articulation for the basis of the stated rejection.

The Office has also erred in establishing its factual findings used in concluding that the features of claim 1 are obvious. See, M.P.E.P. 2141(IV). The Office indicates that *Killion* discloses all of the features of claim 1, except for a controlling device that is a switch selected from the group consisting of a push button, a tragus responsive switch, and a turning knob. See, Office action, page 3. However, as discussed in further detail below, *Killion* (and the other cited references) also does not disclose, at the least, a controlling device that forms part of one or more sound inlets ports.<sup>1</sup> See, M.P.E.P. 2143.

For example, *Killion* discloses a microphone assembly (1) having an elongated actuator switch (10, 75) configured to slide over a microphone housing (3, 35) for selectively covering and uncovering a sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). The actuator switch (10, 75) is a separate element from, and generally spaced above, the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). In this position, the actuator switch (10, 75) forms no part of the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49).

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<sup>1</sup> And the Office does not specifically address this feature of claim 1 in the current rejection of claim 1. See, Office Action, pages 2-3.

Further, Applicants find no teaching, suggestion, or motivation in the prior art (either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art) (and none was provided in the Office action) to modify the cited references to include this feature (e.g., a controlling device that forms part of the one or more sound inlet ports). See, M.P.E.P. 2143. For example, a person skilled in the art would not consider modifying the sliding actuator switch (10, 75) of *Killion* to form a part of the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49) because such modification would require substantial modification to *Killion*'s microphone assembly (1). As previously stated, *Killion*'s actuator switch (10, 75) is disclosed as separate from the inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). Any modification to make the sliding actuator switch (10, 75) physically/structurally form a part of the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49) would require substantial and non-obvious constructional/structural changes to the housing (3, 35) of the microphone assembly (1).

For at least the foregoing reasons, the present rejection of claim 1 cannot be sustained because a *prima facie* case of obviousness has not been established. A clear articulation of the reason(s) why the claimed invention recited in claim 1 would have been obvious has not been provided, and the factual findings used in concluding that the features recited in claim 1 are obvious are incorrect. The present rejection of claims 3, 4, 6, 8-10, 12, 17, and 34 which depend from claim 1 also cannot be sustained for at least the same reasons as set forth above for claim 1. Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1, 3, 4, 6, 8-10, 12, 17, and 34 under 35 U.S.C. § 103(a).

Claim 40 depends indirectly from claim 36 and is submitted as patentable for at least the same reasons as set forth below for claim 36. In addition, claim 40 is believed to be further patentably distinguishable because the cited references do not disclose, teach, or suggest the additional features required by it in combination with the other features recited in independent claim 36 from which it depends. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 40 under 35 U.S.C. § 103(a).

### III. Claim Rejections: 35 U.S.C. § 102

Claims 36-39, 41, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Killion*. Applicants request reconsideration and withdrawal of these rejections for at least the following reasons.

Claim 36 is generally directed toward a microphone assembly for mounting in an electronic communication device. The microphone assembly generally comprises a microphone housing and a sound inlet port for passing sound to the microphone housing. The sound inlet port includes a controlling device forming at least part of the sound inlet port. The controlling device is operable by a user for selectively controlling operation of the microphone assembly.

As described above, *Killion* discloses a microphone assembly (1) having an elongated actuator switch (10, 75) configured to slide over a microphone housing (3, 35) for selectively covering and uncovering a sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). The actuator switch (10, 75) is a separate element from, and generally spaced above, the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). In this position, the actuator switch (10, 75) forms no part of the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49).

*Killion* does not disclose, at the least, that the actuator switch (10, 75) forms part of the sound inlet port/tube (e.g., 7, 9, 11, 13, 43, 45, 47, 49). With regard to this feature in *Killion*, the Office briefly states that “[a]s shown in the drawings, the sound inlet port includes a controlling device (10, 75) forming at least part of the sound inlet port ... .” Office Action, page 4. But the Office does not indicate where this feature is shown in *Killion*’s drawings. Applicants submit that this feature is in fact not shown in any of *Killion*’s drawings.

Because *Killion* fails to teach each of the features of amended claim 36, Applicants submit that amended claim 36 is therefore patentable over *Killion* (as well as the other references of record). Accordingly, reconsideration and withdrawal of the rejection of claim 36 under 35 U.S.C. 102(e) is requested. Claims 37-39, 41, and 42 depend from claim 36 and are submitted as patentable for at least the same reasons set forth above for claim 36. Reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. 102(e) is also requested.

#### IV. New Claims 43-45

Claims 43-45 are added herein and are supported by the application as originally filed. No new matter is introduced by the addition of these claims.

Claim 43 depends from independent claim 1, which Applicants believe to be allowable for at least the reasons stated above. As such, Applicants submit that dependent claim 43 is also allowable at least because of its dependence from allowable independent claim 1. In addition, dependent claim 43 is believed to be further patentably distinguishable over the references of record because they do not anticipate or make obvious the additional features as required by this claim (in combination with features recited in independent claim 1), including, for example, wherein the controlling device includes a user operable actuator having a generally rounded outer configuration. Applicants submit that this structural configuration of the controlling device is not disclosed or made obvious by the references of record, including *Killion*.

Claim 44 depends from independent claim 36, which Applicants believe to be allowable for at least the reasons stated above. As such, Applicants submit that dependent claim 44 is also allowable at least because of its dependence from allowable independent claim 36. In addition, dependent claim 44 is believed to be further patentably distinguishable over the references of record because they do not anticipate or make obvious the additional features as required by this claim (in combination with features recited in independent claim 36), including, for example, wherein the controlling device includes an actuator having a generally rounded outer configuration. Applicants submit that this structural configuration of the controlling device is not disclosed or made obvious by the references of record, including *Killion*.

Claim 45 is a new independent claim directed toward a microphone assembly for mounting in an electronic communication device. The microphone assembly generally includes a sound inlet port, and a controlling device that can be operated by a user for selectively controlling the operation of the assembly. The sound inlet port and the controlling device can be combined to form an integrated microphone assembly. The controlling device forms part of the sound inlet port. And the controlling device includes a user operable actuator having a generally rounded outer configuration. Applicants do not believe that the references of record anticipate or make obvious the unique features of new claim 45, including, for example, a controlling device including a user operable

actuator having a generally rounded outer configuration. As such, Applicants submit that independent claim 45 is allowable.

**V. Conclusion**

In view of the above remarks and amendments, Applicants respectfully submit that each of the Office action rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

Applicant hereby petitions under the provisions of 37 C.F.R. § 1.136(a) for an extension of time in which to respond to the outstanding Office Action and includes a fee as set forth in 37 C.F.R. § 1.17(a) with this response for such extension of time.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. **08-0750** for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,  
HARNESS, DICKEY, & PIERCE, P.L.C.

By



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